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Atty Dkt No. 5100-0005
USSN: 09/750,223
PATENT

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12/15/03 _____
Date Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

DANIELS et al.

Serial No.: 09/750,223

Filing Date: December 27, 2000

Confirmation No.: 6599

Group Art Unit: 1641

Examiner: COUNTS, GARY W

Title: IMMUNOCHROMATOGRAPHIC METHODS FOR DETECTING AN ANALYTE IN A SAMPLE WHICH EMPLOY SEMICONDUCTOR NANOCRYSTALS AS DETECTABLE LABELS

RESPONSE TO ADVISORY ACTION OR, IN THE ALTERNATIVE, PETITION TO THE COMMISSIONER PURSUANT TO 37 CFR 1.181(A)

Box AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is presented in order to address the Examiner's remarks set forth in the Advisory Action dated November 28, 2003. The Examiner therein specifically stated on the cover page of the Advisory Action that the 103(c) Declaration **had been considered** but did not place the application in condition for allowance. In particular, the Examiner stated the Declaration was not sufficient because (1) "there is no evidence in the application why evidence of a 103(c) was not presented earlier;" (2) "the supplemental declaration creates an issue of inconsistency concerning the declarations;" and (3) "while the declaration implicates 103(c) and therefore would likely remove Bruchez as prior art, additional references teaching the advantages of quantum dots as a label are well known

in the art." However, applicants submit that none of these reasons are sufficient to warrant maintaining the current rejection and address each statement in turn.

(1) Applicants are unaware of any provision in the Patent Statutes requiring submission of a 103(c) Declaration at a particular time. Since the Examiner stated the Declaration had been considered, he cannot be basing this statement on the fact that it was filed after a final rejection. Thus, clarification regarding the statement is respectfully requested.

(2) With respect to the alleged inconsistencies, applicants submitted a Declaration of Inventorship with the Amendment filed April 28, 2003 in order to remove Bruchez as a prior art reference. However, upon further review by applicants' in-house counsel, it became apparent that Bruchez was indeed an inventor of subject matter claimed in the present application. Accordingly, when this fact came to the attention of the undersigned, the error was promptly corrected.

(3) Applicants frankly do not know how to respond to point 3. The rejection has not been set forth with particularity such that applicants can address the rejection herein or in an appeal brief. This is wholly improper. Moreover, it is also improper to make such an art rejection in an Advisory Action. It is axiomatic that an art reference should not be newly raised by an Examiner during prosecution unless the applicant is afforded a fair and reasonable opportunity to directly address the reference. Accordingly, an Examiner cannot properly make final a rejection which includes newly cited references (see, *e.g.*, MPEP, 706.07(a)) that could have been cited previously. Certainly, it is even more objectionable to cite, as in the pending case, an unknown reference for the first time in an Advisory Action, where an applicant's only opportunity to address it is in an Appeal Brief. Thus, because applicants have had no opportunity to address the Examiner's vague art rejection, making such as rejection at this late date in prosecution is wholly improper and constitutes an abridgment of applicants' Due Process rights.

Furthermore, as stated in MPEP 706.07, "the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied ...

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Switching from ... one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will [alike] tend to defeat the goal of reaching a clearly defined issue for an early termination." Here, the Office is attempting to switch from the various combinations cited in the previous Office Action to some unknown art references. Applicants have provided declaratory evidence removing Bruchez as prior art, thereby eliminating all of the cited combinations which included Bruchez. Thus, if the Examiner wishes to maintain the new rejections, he must specify the particular references relied on and withdraw the previous holding of finality.

Should the Examiner decide against withdrawing finality, applicants wish this request to be treated as a Petition to the Commissioner Pursuant to 37 CFR 1.181(a). The Commissioner is authorized to charge any required fees to deposit account number 18-1648. **A duplicate copy of this request is attached hereto,** as required.

Favorable action by the Office is respectfully requested.

Respectfully submitted,

Date: 12/15/03

By: _____
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